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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,242	05/15/2001	Ryohei Sato	14632	8991

23389 7590 02/23/2005

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER	
QUINONES, ISMAEL C	

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,242	SATO, RYOHEI	
	Examiner	Art Unit	
	Ismael Quiñones	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 22, 2004 has been entered.

2. **Claims 10-20** are pending in the present application. This Action is made **NON-FINAL**.

Claim Objections

3. **Claim 10** is objected to because of the following informalities: Lack of antecedent basis for the following issues:

i. "sub-communication means", in line 6 when introducing the limitation, it should be referred as "a sub-communication means"

ii. "cellular transceiver means", in line 11 when introducing the limitation, it should be as "a cellular transceiver means"

iii. "sub-communication" in line 18, when instead "sub-communication means" was introduced before.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 10 and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claims 10 and 19** recites the limitation "a call other than a call used by the cellular telephone set to perform said sub-communication" in lines 17-18 and line 7 respectively. There is insufficient antecedent basis for this limitation in the claim. There is no mention of a call used to perform said sub-communication.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 10-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokoro (U.S. Pat. No. 6,349,324) in view of Tsai (U.S. Pat. No. 6,757,301).

Regarding **claim 10**, Tokoro discloses a cellular telephone apparatus which has a cellular telephone set capable of originating a plurality of calls to a base station (*col. 4, lines 48-50; Fig. 1*) and communicating with an accessory through sub-communication means (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and said accessory capable of communicating with said cellular telephone set through said sub-communication means (*Fig. 3, items 37, 39-40, 202, and 205*), and can execute a communication function other than a voice communication function by said cellular telephone set through said sub-communication means (Generating an infrared request signal for television-telephone connection; *col. 8, lines 49-62*), said cellular telephone set comprising: cellular telephone transceiver means for originating a plurality of calls to a base station (*Fig. 2, radio communication unit, items 22, and 23*); sub-communication means for performing communication with said accessory (*Fig. 3, items 37, 39 and 40*); control means for causing said cellular telephone transceiver means to start originating a call other than a call used by the cellular telephone set to perform said sub-communication for voice communication with a remote cellular telephone set (Turning off the television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*), and said accessory comprises: sub-communication means for performing communication with said cellular telephone set (*Fig. 3,*

items 37, 39-40, 202, and 205); expression means for expressing a content transferred by said sub-communication means (*Figs. 1 and 4, items 205 and 305*). Tokoro fails to specifically disclose both cellular telephone apparatus and accessory comprising channel monitoring means for monitoring channel quality of said sub-communications means and control means for when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level notifying said cellular telephone set of the corresponding information and causing said cellular apparatus to start originating a call. Tokoro however does suggest the aforesaid limitation such as one user using a portable-telephone device moving from one place to another wherein degradation or deterioration of a channel or a communication path such as infrared communications can occur as a result of the user moving away from an accessory or terminal adapter, thus utilization or employment of an expression or image display means is unnecessary at that particular instance.

Furthermore in the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the

quality of a communication means for switching between appropriate communication modes as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Regarding **claims 11 and 12**, and as applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. In addition Tokoro discloses wherein said accessory comprises a videophone unit and a musical unit (A television unit for generating video ad audio signals; *col. 7, lines 4-20; Fig. 1, item 205*).

Regarding **claims 13-15**, and as each applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. In addition Tokoro discloses wherein said sub-communication means is infrared communication (*Fig. 1, infrared ray*).

10. **Claims 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokoro (U.S. Pat. No. 6,349,324) in view of Tsai (U.S. Pat. No. 6,757,301), further in view of Tryding (U.S. Pat. No. 5,880,732).

Regarding **claims 16-18**, and as each applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. Tokoro in view of Tsai fail to clearly specify wherein said sub-communication is a radio communication.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro in view of Tsai communication system for switching communication modes to include a direct

radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Regarding **claim 19**, Tokoro discloses a method for a cellular telephone apparatus including a cellular telephone set capable of originating a call in addition to a call for voice communication (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and an accessory capable of communicating with the cellular telephone set by using a channel for sub-communication (*Fig. 3, items 37, 39-40, 202, and 205*), when the cellular telephone set can perform voice communication with a remote cellular telephone set (*col. 4, lines 48-50; Fig. 1*), the cellular telephone set is allowed to perform voice communication with the remote cellular telephone set by originating a call other than a call used by the cellular telephone set to perform said sub-communication (Turning off the television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*). Tokoro fails to specifically disclose wherein the channel is a radio channel and the channel quality of a channel for the sub-communication deteriorating to not more than a predetermined level. Tokoro however does suggest the deterioration of the channel to not more than a predetermined level such as one user using a portable-telephone device moving from one place to another wherein degradation or deterioration (a predetermined level relative for determining deterioration) of a channel or a communication path such as infrared communications can occur as a result of the user moving away from an accessory or terminal adapter, thus utilization or employment of an expression or image display means is unnecessary at that particular instance.

In the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the quality of a communication means for switching between appropriate communication modes as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Tokoro in view of Tsai fail to clearly specify wherein the channel for sub-communication is a radio channel.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro in view of Tsai communication system for switching communication modes to include a direct radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Regarding **claim 20**, Tokoro discloses A communication method of communicating between cellular telephone apparatuses with each other, each of said apparatuses including a cellular telephone set capable of originating a call in addition to a call for normal voice communication (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and an accessory capable of communicating with the cellular telephone set by making use channel for sub-communication (*Fig. 3, items 37, 39-40, 202, and 205*), comprising the steps of: inputting a telephone number of a remote cellular telephone apparatus by operating a ten-key mounted in an originating cellular telephone apparatus so as to start the sub-communication (*col. 5, lines 36-42; Fig. 2, items 16 and 16A*); transmitting corresponding information through infrared light from the accessory to a cellular telephone set mounted in said originating cellular phone apparatus so as to originate a call (*col. 5, lines 56-63; col. 8, lines 48-53; Fig. 2, item 16A*); starting communication from the cellular telephone set mounted in said originating cellular telephone apparatus to the remote cellular telephone apparatus through base stations (*col. 7, line 63 thru col. 8, line 7; Fig. 1, items 201, 301, 231-1, and 231-2*) and activating display units to transmit and receive a sensed image signal and the like and display a corresponding images so as to perform videophone communication (*col. 12, line 8 thru col. 13, line 7*); checking whether communication using a voice call can be performed between cellular telephone sets respectively mounted in said cellular telephone apparatuses (The portable telephone outputting an electric wave conveying a calling signal to the closest base station, then an electric wave conveying the call signal is transmitted by the base station to another portable telephone for voice communications; *col. 7, line 63 thru col. 8, line 47*); originating a call from the cellular telephone set mounted in the originating cellular telephone apparatus to the cellular telephone set mounted in the remote cellular telephone

apparatus (*col. 7, line 63 thru col. 8, line 47*); starting voice communication when the voice call is originated (*col. 7, line 63 thru col. 8, line 47*); and terminating the sub-communication (Turning off the television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*). Tokoro fails to specifically disclose monitoring a channel quality of the sub-communication whether the channel quality has deteriorated to a predetermined level or less.

In the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the quality of a communication means as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Tokoro in view of Tsai fail to clearly specify wherein the channel for sub-communication is a radio channel.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro in view of Tsai communication system for switching communication modes to include a direct radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Response to Arguments

11. Applicant's arguments with respect to claims 10-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kosaka (U.S. Pat. No. 6,281,925), Video Telephone Device Having Automatic Sound Level Setting Along with Operation Mode.

b. Newlin et al. (U.S. Pat. No. 6,011,909), Alerting User Engaged in a First Communications Session on a First Network to a Request to Establish a Second Communication Session on a Second Network.

c. Downing et al. (U.S. Pat. No. 6,373,855), System and Method for Using Audio Performance to Control Video Bandwidth.

d. Hicks, III (U.S. Pat. No. 5,760,824), Multimedia Telephone Having Wireless Camera and Television Module and Method of Operation Thereof.

e. Sato (JP 03-85980), Video Telephone System.

f. Fujii (JP 09-368996), Data Communication System by which a proper service is selected.

g. Ogura (JP 08-089000), Radio Communication System.

h. Nakano (U.S. Pat. No. 5,619,252), Video Telephone System and Method for Transmitting and Receiving Signals When There is a Failure in the System.

i. Burkman (EP 0 743 792 A1), Video Conferencing System.

j. Fitzgerald et al. (U.S. Pat. No. 6,611,503), Method and Apparatus for Multimedia Conferencing with Dynamic Bandwidth Allocation.

13. Any response to this Office Action should be **faxed to** (703) 872-9306 or **mailed to:**

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Crystal Park II

2021 Crystal Drive

Arlington, VA 22202

Sixth Floor (Receptionist)

14. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

15. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.

Ismael Quiñones

I.Q

February 18, 2005

RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
2/22/05